

Attorney Docket No.: DID-101
Appl. Ser. No.: 10/084,283

PATENT

REMARKS

Applicant submits that the present Supplemental Amendment in and by itself, and in addition to the Applicant Response filed April 27, 2007, are fully responsive to the Office Action dated October 26, 2006 and, thus, the application is in condition for allowance.

By this reply, claims 48, 50 and 52-67 remain pending. Claims 29-34, 37-45 and 47 remain withdrawn from consideration at this time. Of the pending claims, claims 48, 50, 52, 53, 58, 59 and 62 are independent. An expedited review and allowance of the application is respectfully requested.

Applicant and his representative want to express their gratitude to the Examiner of Record for graciously agreeing to an Examiner Interview which was held at the U.S. Patent Office on Wednesday, May 16, 2007. During such meeting, the Applicant showed and demonstrated a prototype of the product, further providing visual demonstration of an exemplary product encompassed by an exemplary embodiment of the present invention. Additionally, discussions were held that provided further consideration of the priority of the current invention as recited in the pending claims, and in particular, encompassed in Figure 9A. Applicant's representative provided direct reference to text and drawings within the earliest filed provisional application, filed February 26, 2001, that showed the initial disclosure of the embodiments further recited in the pending claims. This is direct evidence that the embodiments of the invention recited in the pending claims find support in the earliest filed provisional application, namely that filed on February 26, 2001. It is respectfully asserted that, despite the differences between the Morris reference and the present application, a substantive discussion of the Morris reference is not necessary or required because the Morris reference cannot act as "prior art" under any section of 35 U.S.C. § 102 because the present application has a priority date well

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before even the earliest priority date of Morris, even considering the fact that no *prima facie* evidence was presented that the earliest priority date for Morris even had the support needed for any such basis for rejection based on the published application cited herein. Further discussion of these issues were held, and are embodied within the below discussion as well.

In the outstanding Office Action, claims 48, 50, 52, 62-65 and 67 were rejected under 35 U.S.C. § 102(e) as being anticipated by Morris (U.S. Pub. App. No. 2004/0249394). It is asserted that Morris discloses a device that is substantially the same as the present invention as recited in the pending claims. Thus, it is concluded that Morris anticipates the present invention as recited in the present claims. Applicant respectfully traverses.

Without considering any substantive differences between the cited art and the present invention as recited in the pending claims, Applicant notes that Morris cannot qualify as "prior art" under any US statute because the priority dates of the present application pre-dates any which Morris could possibly claim priority back to. Support for the scope of the invention as recited in the currently pending claims is directly found in the earliest filed provisional application cited above.

The present application was filed on February 26, 2002, well before the filing date of the single reference cited, the Morris reference, (April 1, 2004) or its parent (June 7, 2002). The present application also claims priority back to two provisional applications, filed on February 26, 2001 and August 20, 2001. It is clear that the Applicant had conceived of the invention, as recited in the pending rejected claims, at least by the filing date of February 26, 2001, as evident in the embodiments shown and described within the provisional application filed on such date. See, for example, figures 3 and 4, which show and disclose embodiments of the present invention which are within the scope of the presently pending claims. Thus, right of priority to

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the present invention, as recited in the pending, but rejected claims, extends back to at least the date of filing of the initial provisional patent application, namely February 26, 2001.

In such earliest filed provisional application, filed February 26, 2001, the features of the invention as recited in the pending independent claims were clearly shown and presented. In contrast to the assertions in the "Response to Arguments" section on page 4 of the outstanding Office Action, a "straightening means" as well as the other recited language in this section are clearly shown in Figures 2, 3 and 4 of the earliest filed provisional application dated February 26, 2001. An example of a "straightening means" is the "inserter" shown in Figure 2 of the earliest filed provisional application. Another example is the elongate member shown in Figures 3 and 4 of the earliest filed provisional application, wherein such member is used to straighten the suture advancing means, which in this example is the needle. As can also be seen from these Figures in the earliest filed provisional application, an elongate member directs the suture through an elongate tube through a jaw of the grasping mechanism. See Figures 3 and 4 of this provisional application. Furthermore, textual support for these features and presented through the specification of the earliest filed provisional application, including pages 1-6. If any of this support is unclear, the Examiner is respectfully urged to contact the Attorney of Record so he is able to specifically point out such features within the drawings to the Examiner.

In sharp contrast, the cited reference, Morris, has a filing date of April 1, 2004, over a year beyond and thus well after the filing date (February 26, 2002) of the present application. Furthermore, the cited Morris reference claims to be a continuation-in-part ("CIP") of a prior application, 10/165,468, filed on June 7, 2002. Even assuming that its predecessor patent application contained teachings which could have been material to the present claims, again, the filing date of even this CIP application is nearly four months after the filing date (February 26,

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2002) of the present application. Thus, even the CIP, in and of itself, cannot act as "prior art." The CIP claims priority to a provisional patent application, 60/310,220, filed on August 6, 2001. There is absolutely no indication that this provisional patent application disclosed material which could be used in any substantive rejection of the present claims. Even though no such proof is presented, it is important to point out that even if, *arguendo*, this earliest filed Morris provisional application (filed August 6, 2001) contains or recites material that may be considered material to the patentability of the present application, it is still inapplicable as "prior art" under any statutory provision because its date is after the earliest date of priority of the present application.

The Office Action has rejected the current claims under 35 U.S.C. § 102(e). However, such section requires that a reference be a patent application by another and filed before the invention by the Applicant. However, since it has been shown above that the Morris reference, at best, has filing or priority dates that are *after* the Applicant's invention, namely after the earliest priority dates of the present application, a proper 35 U.S.C. § 102(e) is inapplicable in the present case, Morris cannot act as "prior art," and the rejection should be withdrawn.

In the outstanding Office Action, claims 53-61 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Morris in view of Klein (U.S. Pat. No. 4,491,135) and Smith (U.S. Pat. No. 5,797,961). It is asserted that Morris discloses substantially the same device as recited in the pending claims but for a needle having an opening receiving the suture. It is then asserted the Klein and Smith teach such deficiency and therefore it would have been obvious to combine the teachings of Morris, Klein and Smith to render obvious the present invention as recited in the pending claims. Applicant respectfully traverses.

Neither Morris, Klein nor Smith, nor any other related art of record, alone or in combination, disclose or fairly suggest the present invention as recited in the pending claims. As

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discussed in detail above, Morris cannot qualify as "prior art" under any US patent statute and, therefore, cannot be used in the rejection of the claims pending herein. Thus, without the use of Morris, the current rejection based on a combination of references cannot stand. Also, because Morris cannot be used as prior art, no substantive discussion will be presented. Furthermore, neither Klein nor Smith discloses the current invention as recited in the pending claims, such deficiency in teaching being admitted in the Office Action.

If any fees are associated with the entering and consideration of this request for consideration, please charge such fees to our Deposit Account 50-2882.

As all of the outstanding rejections have been traversed and all of the claims are believed to be in condition for allowance, Applicant respectfully requests issuance of a Notice of Allowance. If the undersigned attorney can assist in any matters regarding examination of this application, Examiner is encouraged to call at the number listed below.

Respectfully submitted,

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